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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,841	04/06/2001	Michael Stirn	PR1044	5082

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EXAMINER

CHUKWURAH, NATHANIEL C

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,841

Applicant(s)

STIRM, MICHAEL

Examiner

Nathaniel C. Chukwurah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-9,11,13 and 15-20 is/are rejected.
- 7) ☒ Claim(s) 2, 10, 12 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in US on 4/6/2001. It is noted, however, that applicant has not filed a certified copy of the priority application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "by way of" on line 5 is confusing and unclear as to what applicant is referring to as "by way of". Applicant is reminded also to check for reoccurring phrase in the other claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 11, 16-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Ichijyou et al. (US 6,035,945).

Ichijyou et al. discloses a rotary hammer comprising: an intermediate shaft (14) driven by a motor (1), a spindle (cylinder 19) driven by the intermediate shaft, a tool holder ("H" as designated in fig. 1), a pneumatic hammering arrangement as shown in Figure 1, a piston (16), a mode changing mechanism (see figs. 2-4 for example), a single actuator ("A" as designated in fig. 8), a spindle driving member ("S" as designated in fig. 4) rotatable on the intermediate shaft and for driving the spindle, a hammer driving sleeve (motion converting member 4), a mode change sleeve (6), a spring (7) for biasing the mode changing sleeve, a ram (percussion element 17), an anvil (intermediate element 18) and a wobble plate arrangement ("I", "J", "K", "L" as designated fig. 1). The switching of the actuator (8) by a user, shifts the mode change sleeve as describe in column 5, lines 15-67 and column 6, lines 34-63. Further, the intermediate shaft is substantially parallel to the spindle as shown in Figure 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-9, 13, 15, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichijyou et al. in view of Sanders (5,056,607).

Although Ichijyou et al. does not specifically disclose a driven member and a driving member, the mode changing sleeve (6) and spindle drive member inherently include a driven member and a driving member (teeth) with which to engage a gear and/or clutch in switching to a desired mode (see col. 4, lines 43-45). Ichijyou et al., further shows axially extended driving member (10) for engaging a driven member. Ichijyou et al. discloses a mode changing member as shown in Figure 3 including an actuator (8) for shifting the sleeve, a spindle lock (rotation restricting member 9) for locking the spindle against rotation, a rotatable knob ("A" as designated in fig. 8), an eccentric pin ("P" as designated in fig. 8). Ichijyou et al. does not show a detent for releasably latching the actuator (8), it would have been obvious to a skilled artisan to include a detent in Ichijyou et al.'s rotary hammer in order to latch the actuator in any desired mode position.

Ichijyou et al. lacks housing part. However, Sanders discloses housing part (see figs. 3 & 4 for example). In view of the teachings of Sanders, it would have been to one skilled in the art to provide the rotary hammer of Ichijyou et al. with housing part since to so is within the

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purview of the skilled artisan who is concerned with tool housing. Further, the tool housing part as claimed does not produce any unexpected result.

Allowable Subject Matter

Claims 2, 12, 10 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wache (US 5,036,925),

Hoser (US 5,125,461),

Lauterwald (US 6,015,017),

Arakawa et al. (US 5,842,527) and

Rauser (US 5,379,848), all disclose similar rotary tool.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathaniel C. Chukwurah whose telephone number is (703) 308-6385. The examiner can normally be reached on M-F 6:00AM-2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (703) 308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 308-7769 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Nc

December 17, 2002

A handwritten signature in black ink, appearing to be 'S.A. Smith', written in a cursive style.

SCOTT A. SMITH
PRIMARY EXAMINER